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EXAMINER

LETT, THOMAS J

ART UNIT

PAPER NUMBER

2626

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,270

Applicant(s)

HIRAI ET AL.

Examiner

Thomas J. Lett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-38 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 17 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: Detailed Action.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 20, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Murata (USPN 6,330,067 B1).

With respect to claim 1, Murata discloses a facsimile (digital copier of Fig. 1 capable of facsimile transmission, col. 2, lines 1-7) comprising:

a scanner (image scanner section 100, col. 6, line 25-28) for capturing an image;

a memory card reader (PC card slot 89, col. 3, line 23) for reading image data from memory card;

a modem (modem 87, col. 7, lines 47-49) for modulating and demodulating image information into and from the data that can be transmitted and received through a communication line (a public network, col. 7, line 49);

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an operating unit (operation section 300 with CPU 85 controls functions of the copy machine of Fig. 1, col. 6, lines 22-24) operable to be coupled to the memory card reader, the modem, and the scanner, the operating unit being operable to select an image from one of the memory card, the communication line, and the scanner (operation section 300 with CPU 85 can select an image from (1) a memory card, (2) an incoming facsimile, and (3) a scanned image, and see Fig. 1); and

a printing unit (laser printer section 200 of the digital copier can print an image from any of scanner 100, PC Card slot 89, and a facsimile from a public network, col. 6, lines 29-36) for printing the selected image, according to an instruction from said operating unit (operation section 300 with CPU 85).

With respect to claim 20, Murata discloses a facsimile according to claim 1, wherein said printing unit prints, according to an instruction from said operating unit, information corresponding to the image data read out from said memory card (laser printer section 200 of the digital copier can print an image from any of scanner 100, PC Card slot 89, and a facsimile from a public network, col. 6, lines 29-36).

With respect to claim 23, Murata discloses a facsimile according to claim 1, wherein the memory card is detachable (user pulls out the memory card storing the print job command file and the image data file from the user's personal computer and inserts the memory card into PC card slot 89, col. 10, lines 10-13) from said facsimile.

3. Claims 11-15, 17, 19, 25-29 and 33-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomat et al (USPN 6,784,925 B1).

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With respect to claim 11, Tomat et al disclose a communication terminal (computer system 1, see Fig. 1) comprising:

a memory card reader, for loading and unloading a memory card and reading image data from said memory card (digital camera 14 reads images stored in the memory within the removable camera memory card col. 10, lines 23-34);

a receiver (Computer system 1, col. 6, lines 1-8) for receiving image information through a communication line (network connection 9, WWW connection 10, col. 6, line 2);

an operating unit (fixed disk 6 contains applications (toolbox, port monitor, etc.) necessary to select and retrieve images from connected sources, col. 6, lines 1-8; In addition, Examiner notes that Tomat et al also disclose the use of TWAIN which links applications and image acquisition devices) operable to be coupled to the memory card reader and the receiver, the operating unit being operable to select an image from one of said memory card and said communication line; and

a printing unit (printer 12, see Fig. 1 and col. 6, lines 3-5) for printing the selected image.

With respect to claim 17, Tomat et al disclose a communication terminal according to claim 11, further comprising an image data format converter for converting the image data stored in said memory card into data conforming to the ITU-T T.81 Standard (Save Photo input area 134 determines a format to which a downloaded JPEG photo file will be converted prior to saving. Area 134 includes a pull-down button for displaying a list of possible image formats. In a preferred embodiment, the provided

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formats consist of: native camera format; Windows bitmap (*.bmp); JPEG (*.jpg); TIFF uncompressed (*.tif); and Flashpix (*.fpx), col. 12, lines 6-13).

With respect to claim 19, Tomat et al disclose a communication terminal according to claim 11, further comprising an image data format converter for converting a JPEG image data in a JFIF format of TIFF into data conforming to the ITU-T T.81 Standard (Save Photo input area 134 determines a format to which a downloaded JPEG photo file will be converted prior to saving. Area 134 includes a pull-down button for displaying a list of possible image formats. In a preferred embodiment, the provided formats consist of: native camera format; Windows bitmap (*.bmp); JPEG (*.jpg); TIFF uncompressed (*.tif); and Flashpix (*.fpx), col. 12, lines 6-13).

With respect to claim 28, Tomat et al disclose a communication terminal according to claim 11, wherein said printing unit prints a detailed image of the image data (quality area 370 allows a user to determine the print quality of images printed on the contact sheet. Quick print option 372 prints thumbnail image files of the photo groups selected in photo range area 355, after scaling the files using image up-sampling. Best Quality option 373 utilizes full-resolution image files that are down-sampled and therefore results in a slower but higher-quality printout than that achieved using option 372, col. 20, lines 56-63).

With respect to claim 29, Tomat et al disclose a communication terminal according to claim 11, further comprising an image data format converter for converting the image data stored in said memory card into data in a format for a transmission via a telephone line (Save Photo input area 134 determines a format to which a downloaded

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JPEG photo file will be converted prior to saving. Area 134 includes a pull-down button for displaying a list of possible image formats. In a preferred embodiment, the provided formats consist of: native camera format; Windows bitmap (*.bmp); JPEG (*.jpg); TIFF uncompressed (*.tif); and Flashpix (*.fpx), col. 12, lines 6-13, Examiner notes that TIFF is an example of an image format ready for fax transmission).

With respect to claim 24, Tomat et al disclose a communication terminal according to claim 11, wherein said printing unit prints information corresponding to the image data read out from said memory card (fixed disk 6 contains applications necessary to select and retrieve images from connected sources and send to printer 12 thereafter, col. 6, lines 1-8).

With respect to claim 25, Tomat et al disclose a communication terminal according to claim 24, further comprising a display (see monitor 2 of computer system 1, and Fig. 22) operable to display the information corresponding to the image data read out from said memory card.

With respect to claim 27, Tomat et al disclose a communication terminal according to claim 24, further comprising a display (see monitor 2 of computer system 1, and Fig. 22) for displaying said at least one thumbnail.

With respect to claim 12, Tomat et al disclose a communication terminal according to claim 24, wherein the information corresponding to the image data read out from said memory card comprises at least one thumbnail corresponding to the image data read out from said memory card (files stored in camera memory 36 can be downloaded to an external device via I/O port 37. According to the preferred

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embodiment of the invention, and as described above, microprocessor 35 stores a captured photo in camera memory 36 as a full-resolution image file in JPEG format, and also as a thumbnail resolution, col. 7, lines 5-11).

With respect to claim 13, Tomat et al disclose a communication terminal according to claim 12, comprising a display (see monitor 2 of computer system 1, and Fig. 22) for displaying at least one thumbnail, and

a controller (computer system 1 with keyboard 4 and mouse 5, see Fig. 1) operable to select a specific thumbnail from said at least one thumbnail displayed on said display (from the display of monitor 2 of computer system 1, and see Fig. 22) with said operating unit.

With respect to claim 14, Tomat et al disclose a communication terminal according to claim 13, wherein said operation unit is operable to allow the printing unit to print the image corresponding to the specific thumbnail after said printing unit prints said at least one thumbnail (options 182 and 183 respectively provide a user with printout of small thumbnail images and large thumbnail images on contact sheet, col. 13, lines 47-49).

With respect to claim 15, Tomat et al disclose a communication terminal according to claim 13, further comprising numeric keys for selecting the specific thumbnail (see Fig. 22, where Examiner notes that the numbered thumbnails can inherently be selected with the numbered keys of a keyboard 4, or even selected with a mouse 5).

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With respect to claim 26, Tomat et al disclose a communication terminal according to claim 13, wherein said controller is operable to automatically control said display for allowing said display to display said at least one thumbnail if said operation unit selects the image from the memory card (see Fig. 22).

With respect to claim 33, Tomat et al disclose a facsimile comprising:
a communication interface (Computer system 1, col. 6, lines 1-8) for transmitting and receiving image data through a telephone line (a network via network connection 9, col. 5, lines 62-65);

a scanner (scanner 11, see Fig. 1) for capturing image data;

a memory card reader (camera 14, see Fig. 1) for reading image data from a memory card loaded to the memory card reader; and

a printing unit (printer 12, see Fig. 1) operable to print the image data received by the communication interface, the image data captured by the scanner, and the image data read from the memory card;

a controller (computer system 1 with keyboard 4 and mouse 5, see Fig. 1) operable to allow the printing unit (printer 12, see Fig. 1) to print information corresponding to the image data read from the memory card.

With respect to claim 34, Tomat et al disclose a facsimile according to claim 33, wherein the information comprises thumbnails of the image data (files stored in camera memory 36 can be downloaded to an external device via I/O port 37. According to the preferred embodiment of the invention, and as described above, microprocessor 35

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stores a captured photo in camera memory 36 as a full-resolution image file in JPEG format, and also as a thumbnail resolution, col. 7, lines 5-11).

With respect to claim 35, Tomat et al disclose a facsimile according to claim 33, wherein the information comprises thumbnails of the image data and respective numbers corresponding to the thumbnails (see Fig. 22 for screenshot of thumbnails with corresponding numbers).

With respect to claim 36, Tomat et al disclose a facsimile according to claim 33, further comprising a display operable to display information about a printing operation by the printing unit (see screenshot of Fig. 19).

With respect to claim 37, Tomat et al disclose a facsimile according to claim 33, further comprising an operation unit for inputting a number indicating the image data to be printed by the printing unit (see Fig. 22, where Examiner notes that the numbered thumbnails can inherently be selected with the numbered keys of a keyboard 4, or even selected with a mouse 5).

With respect to claim 38, Tomat et al disclose a facsimile according to claim 37, wherein the operation unit (keyboard 4) comprises numeric keys for inputting the number, wherein the controller is operable to allow the printing unit to print the image data corresponding to the number input via the numeric keys (see Fig. 22, where Examiner notes that the numbered thumbnails can inherently be selected with the numbered keys of a keyboard 4, or even selected with a mouse 5).

4. Claims 30-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomat et al (USPN 6,784,925 B1).

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With respect to claim 30, Tomat et al disclose a facsimile comprising:

a communication interface (Computer system 1, col. 6, lines 1-8) for transmitting and receiving image data through a telephone line;

a printing unit (printer 12, see Fig. 1) for printing image data;

a memory card reader (camera 14, see Fig. 1) for reading image data from a memory card loaded to the memory card reader; and

an operation unit (computer system 1 with keyboard 4 and mouse 5 using installed software with display 2) operable to select one from:

(a) allowing the communication interface to transmit the image data read from the memory card to the telephone line (Fig. 25 shows send capability of the computer system 1); and

(b) allowing the printing unit to print the image data read from the memory card (fixed disk 6 contains applications (toolbox, port monitor, etc.) necessary to select and retrieve images from connected sources, col. 6, lines 1-8 and send to the printer 12; In addition, Examiner notes that Tomat et al also disclose the use of TWAIN which links applications and image acquisition devices).

With respect to claim 31, Tomat et al disclose a facsimile according to claim 30, wherein the printing unit (printer 12, see Fig. 1) is operable to print information about the image data read from the memory card (see Fig. 19).

make said printing unit (printer 31) print an image corresponding to the specific thumbnail (see Fig. 22, where Examiner notes that the numbered thumbnails can

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inherently be selected with the numbered keys of a keyboard 4, or even selected with a mouse 5).

With respect to claim 32, Tomat et al disclose a facsimile according to claim 30, wherein the printing unit (printer 12, see Fig. 1) is operable to print a thumbnail of the image data read from the memory card and information corresponding to the thumbnail (fixed disk 6 contains applications necessary to select and retrieve images from connected sources and send to printer 12 thereafter, col. 6, lines 1-8) also (see Fig. 22, where Examiner notes that the numbered thumbnails can inherently be selected with the numbered keys of a keyboard 4, or even selected with a mouse 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata (USPN 6,330,067 B1) in view of Yokoyama (USPN 6,166,826).

With respect to claim 2, Murata does not disclose a facsimile according to claim 20, wherein the information corresponding to the image data read out from said memory card comprises at least one thumbnail corresponding to the image data read out from said memory card. Yokoyama discloses that image data can also be input to the printing apparatus 1 with a memory card storing the image data. Yokoyama discloses

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an image data list file as shown in FIG. 9 displaying thumbnails 55, and see representative images 55 (thumbnails) shown in Fig. 16) corresponding to image files (e.g., Abc.EPS). Murata and Yokoyama are analogous art because they are from the similar problem solving area of image data display. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Yokoyama to Murata in order to obtain a device capable of reading image data from a memory card. The motivation for doing so would be to view data representative of a desired image.

With respect to claim 3, Murata does not teach a facsimile that can select a specific thumbnail from said at least one thumbnail displayed on said display with said operating unit. Yokoyama teaches that at least one file can be selected from an image data list file as shown in FIG. 9 displaying thumbnails 55, and see representative images 55 (thumbnails) shown in Fig. 16; and make said printing unit (printer 31) print an image corresponding to the specific thumbnail (the desired file can be displayed or printed, col. 11, lines 20-25). Murata and Yokoyama are analogous art because they are from the similar problem solving area of image data display and output. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Yokoyama to Murata in order to obtain a device capable of reading image data from a memory card and printing. The motivation for doing so would be to view data representative of a desired image before printing the image.

With respect to claim 4, Murata does not teach a facsimile according to claim 3, wherein said controller is operable to select one from:

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allowing the printing unit to print the image corresponding to the specific thumbnail without printing said at least one thumbnail by the printing unit after said display displays said at least one thumbnail. Yokoyama teaches of an image data list file as shown in FIG. 9 displaying thumbnails 55, and see representative images 55 (thumbnails) shown in Fig. 16 that can be selected for display 53 and printing 54. Murata and Yokoyama are analogous art because they are from the similar problem solving area of image data display and output. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Yokoyama to Murata in order to obtain a device capable of reading image data from a memory card and printing. The motivation for doing so would be to view data representative of a desired image before printing the image.

6. Claims 5, 6, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata (USPN 6,330,067 B1) in view of Yokoyama (USPN 6,166,826), and further in view of Tomat et al (USPN 6,784,925 B1).

With respect to claim 5, Murata in view of Yokoyama do not disclose a facsimile according to claim 3, wherein said operating unit comprises numeric keys for selecting the specific thumbnail from said at least one thumbnail. Tomat et al teach of (computer system 1 with keyboard 4 and mouse 5 using installed software with display 2 and see Fig. 22, where Examiner notes that the numbered thumbnails can be selected with the numbered keys of a keyboard 4, or even selected with a mouse 5. Murata and Yokoyama in view of Tomat et al are analogous art because they are from the similar problem solving area of image data display and output. At the time of the invention, it

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would have been obvious to a person of ordinary skill in the art to add the feature of Tomat et al to Murata in view of Yokoyama in order to obtain a device capable of selecting image data from a display of images. The motivation for doing so would be to select a specific image for processing.

With respect to claim 6, Murata in view of Yokoyama do not disclose a facsimile according to claim 3, wherein said display displays a detailed image corresponding to the specific thumbnail if said controller selects the specific thumbnail (quality area 370 allows a user to determine the print quality of images printed on the contact sheet. Tomat et al teach of a Quick print option 372 that prints thumbnail image files of the photo groups selected in photo range area 355, after scaling the files using image up-sampling. Best Quality option 373 utilizes full-resolution image files that are down-sampled and therefore results in a slower but higher-quality printout than that achieved using option 372, col. 20, lines 56-63); and wherein said printing unit (printer 12) prints the detailed image according to an instruction from said operating unit (see Fig. 19). Murata and Yokoyama in view of Tomat et al are analogous art because they are from the similar problem solving area of image data display and output. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Tomat et al to Murata in view of Yokoyama in order to obtain a device capable of selecting image data from a display of images. The motivation for doing so would be to select a specific image for processing.

With respect to claim 22, Murata in view of Yokoyama do not disclose a facsimile according to claim 3, wherein said controller is operable to automatically control said

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display for allowing said display to display said at least one thumbnail if said operation unit selects the image from the memory card. Tomat et al teach of displaying thumbnails from the display of monitor 2 of computer system 1, and see Fig. 22. Murata and Yokoyama in view of Tomat et al are analogous art because they are from the similar problem solving area of image data display. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Tomat et al to Murata in view of Yokoyama in order to obtain a device capable of displaying image data as thumbnails. The motivation for doing so would be to select a specific image for processing.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat et al (USPN 6,784,925 B1) in view of Sakakibara (USPN 4,900,902).

With respect to claim 18, Tomat et al does not disclose a communication terminal according to claim 11, wherein said memory card is a secure digital (SD) memory card. Sakakibara teaches of a memory card where the identification codes for confidential communication are set in the card, thereby inhibiting reading of the data of the card before corresponding identification codes for confidential communication are input into the apparatus, col. 6, lines 35-43. Tomat et al are analogous art because they are from the similar problem solving area of memory card data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the security feature of Sakakibara to Tomat et al in order to obtain a device capable of protecting image information of a memory card. The motivation for doing so would be to protect data transfer.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

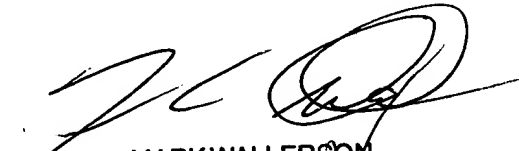
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is 571-272-7464. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJL



MARK WALLERSON
PRIMARY EXAMINER